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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,908	11/16/2001	David Strutt	02310.0054	7906
51871	7590	05/12/2009		
Shumaker & Sieffert, P.A. 1625 Radio Drive, Suite 300 Woodbury, MN 55125			EXAMINER ROBERTSON, DAVID	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/987,908

Applicant(s)

STRUTT ET AL.

Examiner

Dave Robertson

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 12-16, 34 and 36-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 12-16, 34 and 38-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is a Final office action in response to Applicant's reply of 10/02/2008.
2. Status of claims from the Amendment filed 10/02/2008 and after Election of 2/18/2008 are as follows: Claims 1-4, 12-16, 34, 36-45 are pending: claims 1-4, 12-16, and 34, 38, 39, and 40-45 are withdrawn; Claims 36 and 37 are examined herein.

Election/Restrictions

3. Applicant's election without traverse of Group II, Claims 36 and 37, in the reply filed on 2/18/2009 is acknowledged. Examiner notes that claim 39 which depends from non-elected claims 1 and 38 was inadvertently included in the listing for Group II; however, given the dependency and reasons for the election of Group II as independent and distinct from Group I, and claim 39 not containing the elements for which the distinction was based, it is clear that claim 39 belongs to non-elected Group I.

Double Patenting

4. The terminal disclaimer filed on 5/29/2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 09/987,905 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

5. Applicant's arguments with respect to claims 1-35 in the response filed 10/02/2008 are moot in view of claims 1-35 having been cancelled or withdrawn by the present amendment.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 37 recites in the preamble: *A computer-readable medium storing instructions or statements for use in the computer of a method for a business model for a data warehouse, the method comprising steps of....* However, it is unclear as to what statutory class of invention is being claimed, process (*method*) or manufacture (*computer readable medium*) because the body of the claim fails to recite any steps of the *method for a business model* as being performed by the computer or involving the medium in any way. It is also unclear whether *instructions or statements for use in the computer* refer in any way to the method as claimed or the relationship between the computer and the medium with respect to executing the method. Because the claim recites steps of a method, the claim will be interpreted as such.

Amendment is requested.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 36 and 37 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions:

For a process to be patentable subject matter under § 101 the process must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform subject matter to a different state or thing. See *Diamond v. Diehr*, 450 US 175, 184 (1981); *Parker v. Flook*, 437 US 584, 588 n9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 US 780, 787-88 (1876). If neither of these requirements is met by the claim, the method is not a patent eligible process. To qualify under § 101 as a statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim 36 fails to recite transforming subject matter to a different state or thing or positively recite a sufficient tie to another statutory class of invention, such as a particular apparatus. The steps of claim 36 refer only to the gathering and arranging information into a "business model" with no step being performed by any particular apparatus or transforming subject matter to a different state or thing. As such, the method could be performed entirely by a human, by hand, or by mental steps; therefore the invention as claimed is ineligible for patenting and thus nonstatutory subject matter under 35 U.S.C. 101.

Claim 37 recites in the preamble: *A computer-readable medium storing instructions or statements for use in the computer of a method for a business model for a data warehouse, the method comprising steps of...* As properly interpreted above under 35 U.S.C. 112, second paragraph, this method claim fails to recite any

substantive step as performed by the computer or involving the medium in any way. (Mere recitation of an apparatus (a computer) or an article (a medium) in the preamble of a claim does not transform an unpatentable process into a patentable process. Insignificant extra-solution activity (even if recited which is not the case here) such as data gathering, data output, transmitting or display on a computer, does not transform an unpatentable process into a patentable process.)

Therefore, the above, taken together with recitation of the medium storing merely instructions or statements for use in the computer of a method... in the preamble, the claim is instead directed to an unpatentable *process* where "instructions" (a written text description of the method, such as the claim itself) may incidentally be stored on a medium "for use by" a human using a computer to access the instructions for the human to perform. That is, the claim is instead directed to a method of building a business model... (as in claim 36), as is rejected under 35 U.S.C. 101 as above for claim 37, as being directed to non-patentable subject matter.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richard Kimball, The Data Warehouse Lifecycle Toolkit, Wiley:1998, in view of Kimball The Data Warehouse Toolkit" Practical Techniques for Building Dimensional Data Warehouse, Wiley: 1996.

The Kimball texts were submitted in their entirety in the IDS of 06/21/2002 and are reference herein as such. Examiner also notes that citations to passages in Kimball are for the convenience of Applicant. Applicant is advised to consider the Kimball references in their entirety as they teach comprehensively over building data warehouses for managing the performance of organizations, including building dimensional data warehouses configurable for a particular organization from database bus architecture from conformed dimensions as set forth in the following. Applicant is encouraged to further consider any particular aspects of improvement in the claimed implementation of concepts taught by Kimball in the response to this office action.

Claim 36

Kimball teaches **a method of building a business model for a data warehouse, the method comprising the steps of:**

analyzing the particular organization to collect organizational information
(see Chapter 4 "Collecting the Requirements");

determining business questions based on the collected organizational information (see Chapter 4, e.g. Figure 4.2 on page 105 listing specific business questions to ask during interviews of organizational players);

merging the business questions into a subset of areas of analysis of a business model applicable to the particular organization (see Chapter 4, esp. page 128 and Figure 4.6 "merging" the results of organizational interviews to requirements);

decomposing the subset of areas of analysis into dimensions and measures, the dimensions representing business reference aspects of the particular organization, the measures representing measurements of business activity aspects of the particular organization (see Chapters 5-7 teaching comprehensively over dimensional modeling of the business reference aspects of an organization, as depicted by Figures 5.1 and 5.2, and "Facts" (page 165 inter alia) as "measures" of the business activity of the organization);

providing a predefined set of shared common dimensions representing business reference aspects of a plurality of organizations, the plurality of organizations including the particular organization (see Chapter 5, esp. pages 153-160 describing Kimball's "Data Warehouse Bus Architecture", a set of shared, common dimensions from which a plurality of organizations may build data marts from shared "conformed" dimensions);

mapping relationships between the predefined set of shared common dimensions and the second predefined set of measures, the relationships allowing for areas of analysis to use shared common dimensions for cross-functional analysis (see Chapter 5, pages 153-160 describing Kimball's "Data Warehouse Bus Architecture", esp. Page 154, 3rd paragraph, and Figure 5.3 showing mapping of relationships for cross-functional analysis, noting also that Kimball expressly teaches (Figure 5.1) building data warehouses for multiple functional areas using conformed, standard dimensions across the enterprise);

and providing the business model for building the data warehouse (see Chapter 7 "Building Dimensional Models").

Claim 37 recites computer-readable medium storing instructions for performing substantially the steps of the method claims as above, and is similarly rejected for reasons given above, and further that Kimball teaches implementation on computer system (page 513, Figure 13.5).

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Robertson whose telephone number is (571)272-8220. The examiner can normally be reached on 8 am to 6 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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